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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,353	01/14/2004	Helmut Gegalski	1-23211	3328
46582	7590	03/29/2006	EXAMINER	
MACMILLAN, SOBANSKI & TODD, LLC ONE MARITIME PLAZA - FOURTH FLOOR 720 WATER STREET TOLEDO, OH 43604			HONG, JOHN C	
			ART UNIT	PAPER NUMBER
			3726	

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/757,353	Applicant(s) GEGALSKI ET AL.	
	Examiner John C. Hong	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 15-18 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-11 and 15-18 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/6/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Rau (U.S. Patent 5,031,873).

Rau discloses a mounting device for securing a control unit (engine) to a vehicle comprising: an outer supporting structure (40) formed from a non-resilient material, the outer supporting structure having a first end that is adapted to be attached to a vehicle; an inner structure (20) that has a threaded portion adapted to be received in a corresponding threaded bore formed in the control unit and a layer of resilient material (30) disposed between a second end of the outer supporting structure that is opposite from the first end and the inner structure, the layer of resilient material forming an insulative barrier between the outer supporting structure and the inner structure to prevent any direct contact therebetween whereby the resilient material absorbs noise and vibrations (Figs. 1 and 2; col. 3, line 18-35).

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987).

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3. Claim 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Siekmann (U.S. Patent 4303376).

Siekmann discloses a control unit for a vehicle comprising:
an one-piece outer supporting structure (61) formed from a non-resilient material that is adapted to be attached to a device; a layer of resilient material (64) disposed within and attached to the outer structure; and an electronic control unit (11 and 12) for controlling a system disposed in proximity to the layer of resilient material with the layer of resilient material forming an insulative barrier that separates the outer supporting structure from the electronic control unit to prevent any direct contact therebetween whereby the resilient material absorbs noise and vibrations (col. 7, lines 11-20); and an inner supporting structure (22) formed from a non-resilient material that is attached to a surface of the layer of resilient material that is opposite from the outer supporting structure, the inner structure being attached to the electronic control unit ;and a hydraulic valve body (Figs.1, 1a, 2 and 6) attached to the electronic control unit to form a electro- hydraulic control unit, the electro-hydraulic control unit being attached to the inner supporting structure (Figs 3 and 5a).

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham, 2 USPQ 2d 1647 (1987).*

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP403132464.

'464 teaches a mounting device for a securing a control unit to a vehicle comprising: an outer supporting structure formed from a non-resilient material (3) that is adapted to be placed in proximity to a vehicle; and a layer of resilient material (3) disposed within and attached to the outer structure, the resilient material being adapted to be placed adjacent to the control unit (2) whereby the resilient material absorbs noise and vibrations; further including an inner supporting structure formed from a non-resilient material that is attached to a surface of the layer of resilient material that is opposite from the outer supporting structure, the inner structure being adapted to be attached to the control unit; the resilient material is a polymer that is attached to the outer and inner supporting structures; the polymer is rubber and the outer and inner supporting structures are formed from steel; the layer of resilient material is adhesively bonded to the outer and inner supporting structures; the inner and outer supporting structures are generally U-shaped and form a bracket that is

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adapted to secure the control unit to a vehicle; the control unit is an electronic control unit that is attached to a hydraulic valve body to form an electro-hydraulic control unit and further wherein the inner and outer supporting structures are generally U-shaped and form a bracket that is adapted to secure the electro-hydraulic control unit to a vehicle; the resilient material is a polymer that is attached to the outer supporting structure; the polymer is rubber and the outer supporting structure is formed from steel; the layer of resilient material is adhesively bonded to the outer supporting structure (Figs. 1-3, Abstract).

'464 discloses the claimed invention except for the outer support structure is an one piece.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the outer structure of '464 into a integral one piece structure, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. Patent. 164 (1893).

Response to Arguments

6. Applicant's arguments with respect to claims 1-11 and 15-18 have been considered but are moot in view of the new ground(s) of rejection. See the new Office action.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John C. Hong whose telephone number is 571-272-4529. The examiner can normally be reached on M-F(07:00-16:30)First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on 571-272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'JCH', with a horizontal line drawn through the middle of the letters.

John C. Hong
Primary Examiner
Art Unit 3726

jh
march 16, 2006